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09/161,283	09/28/1998	TOMOHIRO MAEKAWA	PMS255979	7428

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08/07/2003

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EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 08/07/2003

33

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/161,283

Applicant(s)

MAEKAWA, TOMOHIRO

Examiner

Kevin R Krueer

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,8-12 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,5,8-12 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The finality of Paper #29 has been removed in light of the newly applied 35 U.S.C. 112, first paragraph rejection. The Office apologizes for any inconvenience and expense the premature finality might have caused.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 2, 5, 8-12, and 15-23 have rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the original disclosure for the limitation "wherein the resin layer (A) has no insoluble methyl methacrylate particles." The examiner reminds Applicant that the mere absence of a positive recitation is not basis for an exclusion. The examiner takes the position that the original disclosure contains neither explicit nor implicit support for such a limitation. Applicant must point out where there is support in the original disclosure for said negative limitation or amend the claim to overcome the rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, 5, 8-12, and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 55-034924A (herein referred to as Toyooka) in view of WO97/30117 (Tadokoro) and Koizumi et al (US 6,309,739) or Toritani et al (US 5,169,903). Toyooka teaches a decorated methacrylic resin plate comprising a printed polyalkyl methacrylate film and a molded methyl methacrylate polymer layer (abstract). According to an on-site translation, the laminate may comprise a polyalkyl methacrylate printed film on both sides of the methyl methacrylate polymer layer.

Toyooka does not teach that the printed methacrylic resin should comprise the claimed outer layer compositions. However, Tadokoro teaches an acrylic film or sheet made from a resin composition comprising 95-50wt% of an acrylic resin which comprises methyl methacrylate as a main component and 5-50wt% of a multilayer-structured acrylic polymer containing an elastomeric layer (abstract). The resin comprises 50-99wt% methyl methacrylate and 50-1wt% of an alkyl acrylate (col 3, lines 38+). The composition may comprise light stabilizers and UV absorbers (col 4, lines 27+). The sheet may be used as a decorative surface film on a molded product (col 2, lines 37+). For example, the sheet may be printed or colored (col 4, lines 51+). Thus, it would have been obvious to one of ordinary skill in the art to utilize the decorative sheet taught in Tadokoro as the polyalkyl methacrylate printed film of the laminate taught in

Toyooka because it maintains surface hardness, and is produced simply and inexpensively.

Tadokoro does not teach the claimed weight average particle size. However, Koizumi teaches a composition comprising 5-50wt% of a crosslinked acrylate elastomer having a two-layered structure, and 50-95wt% of an alkyl methacrylate polymer (abstract). Koizumi teaches that the particle size of the elastomer should have a particle size of at least 0.5-15um, in order to control the film's matting effect, impact resistance, transparency, and flex whitening resistance (col 9, lines 17+). Thus, it would have been obvious to one of ordinary skill in the art to utilize elastomers with a particle size of 0.5-15um in the composition taught in Tadokoro in order to control the composition's matting effect, impact resistance, transparency, and flex whitening resistance.

Response to Arguments

Applicant's arguments filed July 29, 2003 have been fully considered but they are not persuasive.

Applicant argues that the utilization of the decorative sheet taught by Tadokoro as the polyalkyl methacrylate printed film of the laminate taught in Toyooka is rooted in hindsight provided by the claimed invention. The examiner respectfully disagrees. Tadokoro teaches that the composition may be utilized as a decorative surface film on a molded product (col 2, lines 37+). Tadokoro further teaches that the composition may be printed or colored (col 4, lines 51+), and has the further advantage of providing the laminated molded product with surface hardness. Thus, the examiner maintains the

position that one of ordinary skill in the art would have been motivated to utilize the composition taught in Tadokoro as the surface film of the laminate taught in Toyooka because said composition has improved surface hardness and provides the molded article with the desired aesthetic effect.

Applicant argues that the claimed laminate exhibits unexpected results with respect to a smaller bias in thickness. However, the comparative examples in the specification are not representative of the closest prior art (Toyooka). Furthermore, the examples have more than one variable that changes (molding temperature and composition). Thus, no conclusions can be made from the data in the specification. The examiner also notes that the examples are processed in a specific manner. The method of processing the laminate is not claimed. Thus, the claims are much broader than the inventive examples in the specification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:00a.m. to 4:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700